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EXAMINER

FISCHMANN, BRYAN R

ART UNIT PAPER NUMBER

3618

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/659,913

Applicant(s)

SKOFIC ET AL.

Examiner

Bryan Fischmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Specification

1. The abstract of the disclosure is objected to because of the following:

A) It is considered unclear what is meant by the recitation of "if appropriate" on lines 4 and 5.

B) Lines 5-11 are considered to be awkwardly worded and unclear.

2. The specification is objected to because of the following:

A) It is believed a title, such as "Cross-Reference to Related Applications" should appear before paragraph 0001. See Section 608.01(b) of the MPEP.

B) The following recited phrases are unclear, awkwardly worded, and/or grammatically incorrect:

Note: The specification is considered replete with instances of awkward and sometimes unclear wording. Therefore, the Examiner cannot guarantee the following is a comprehensive listing of all awkward and unclear wording. Applicant is advised to review the specification for awkward and unclear wording.

1) It considered which edge, top or bottom, is being referred to by the recitation of "ski edge" on the last line of page 3.

2) It is considered what structure is being referred to by the recitation of "the metallic layer" on line 2 of page 4.

See also line 5 of page 4.

3) To be grammatically correct, it is believed the word "damages" recited on line 21 of page 4, should instead be the singular "damage".

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4) To improve wording, it is believed that the word "of" should appear before the words "the ski" on line 11 of page 5.

5) To improve wording, is believed that the word "an" should appear after the word "such" on line 5 of page 6.

6) Lines 10 and 11 of page 6 recites "the belonging side of the ski". The meaning of this recited phrase is considered unclear.

7) The recitation of "despite to sliding the ski edges" on line 9 of page 7 is considered awkward.

8) Line 15 of page 7 recites "sidely". It is not believed that this term is a word. The intended meaning of this word is also considered unclear.

9) The meaning of the term "at least in its adjacency" recited on line 12 of page 8 is considered unclear.

10) Line 16 of page 11 recites "is shown in form of ordinary profile". It is believed that this phrase is better worded "is shown in the form of an ordinary profile".

Also, the meaning of the above phrase, especially the words "ordinary profile", when read in context, is considered unclear.

11) Paragraph 0018 recites "A further embodiment of a ski, according to Figs. 5-8...".

Paragraph 0019 then recites "Another embodiment of a ski is illustrated in Fig. 5".

This leaves unclear whether Figure 5 is a separate embodiment from Figures 6-8.

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12) It is believed that wording would be improved if the word "of" were inserted before the word "appropriate" on line 7 of page 12.

13) The last two lines of page 14 are considered to be awkwardly worded and also unclear.

C) The following inconsistencies in nomenclature were noted:

1) Line 20 of page 11 recites "flange...83". Line 19 of page 12 then recites "web 83".

To avoid confusion to the reader, and to facilitate identifying components by nomenclature in the claims, it is requested Applicant use consistent nomenclature for the same reference number throughout the specification.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

A) The claimed features of claims 3 and 5-7, which is drawn toward the "alternative embodiment" of Figures 5 and 6, in combination with the "main embodiment" of Figures 1-4. See also the claim objection to claims 3 and 5-7.

B) The claimed features of claim 8, which is drawn toward the "alternative embodiment" of Figures 5-8, in combination with the "main embodiment" of Figures 1-4. See also the claim objection to claim 8.

Information Disclosure Statement

4. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they may not have not been considered.

Note that the Applicant refers to several patents on pages 4-7. While this is acceptable, the Applicant should not necessarily conclude that these references have been considered by the Examiner. While US Patents are readily available to the Examiner, foreign patents are generally more difficult to obtain. While the Examiner was able to obtain some foreign patents such as EP 0530395 mentioned on pages 4-7, other foreign patents such as Slovenian patent application No. P-200100171 and EP 622097 mentioned on pages 4-7 were not available.

Drawings

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign not mentioned in the description: 81". Correction is required.

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the covering layer extending over the top surface and a forward portion between a tip and a ski binding

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area, a rearward portion, as recited in claim 1, the covering layer being interrupted as recited in claims 2-5, the alternate embodiment of Figure 6 in combination with the main embodiment of Figures 1-4, as set forth in claims 3 and 5-7 and the alternate embodiment of Figures 5-8 in combination with the main embodiment of Figures 1-4, as set forth in claim 8 must be shown or the features canceled from the claims. No new matter should be entered.

7. The drawings are also objected to, due to the following:

A) As best understood from paragraph 0017, Figures 1-4 are a "single embodiment". This then leaves unclear to the Examiner why Figures 3 and 4 teach separate structure from Figures 1 and 2.

B) Similarly, as best understood from paragraph 0018, Figures 5-8 are a "single embodiment". This then leaves unclear to the Examiner why Figures 7 and 8 teach separate structure from Figures 5 and 6.

Claim Objections

8. Claims 1-10 are objected to because of the following:

Note: The claims are considered to be replete with objectionable matter.

Therefore, a comprehensive listing of all objectionable matter cannot be guaranteed.

Applicant is advised to review all claims for unclear matter.

A) Claim 1 recites "the ski's bottom surface faced toward the ground".

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The latter portion of this recitation containing the words “faced toward the ground” is objected to as being redundant, since it is inherent that a ski’s “bottom surface” is “facing the ground”.

Note also that the positive recitation of “the ground” in the above recitation may call into question whether Applicant is claiming the “ground” which is non-statutory subject matter.

Additionally note that the first portion of the above recitation containing the words “the ski’s bottom surface” lacks antecedent basis.

B) Claim 1 recites “a covering layer (4) extending over the top surface (5)”.

From examination of Figures 1-4, it would instead appear that the top surface is “over” the covering, as opposed to “vice versa”, as set forth in the above recitation.

Note that since structure related to reference numbers 7’ and 7” is recited in claim 1, that it is best understood that claim 1 is directed toward the embodiment of Figures 1-4.

C) Claim 1 recites “...from contacting into contact with ski edges (2’ 3”) of another ski.

Note that reference number 3” enclosed within parenthesis in the above recitation is not a “ski edge”, but instead is associated by the specification with a “supplemental layer”.

Note also that reference number 3” is only found in Figures 5-8, and it was set forth above that claim 1, as best understood, is directed toward the species of Figures 1-4.

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D) The preamble of claims 2-10 recites "Ski according to Claim...".

It is believed that wording would be improved if the word "The" appeared before the word "Ski" in the preamble of claims 2-10.

E) Claim 1 is best understood to be directed toward the embodiment of Figures 1-4, since claim 1 recites structure corresponding to reference numbers 7' and 7". Claim 3 recites structure "...outward surface...of each reinforcing profile... is rounded...". This feature is only found in Figure 6. Therefore, Applicant would appear to be claiming a "non-disclosed" combination of the embodiment of Figures 1-4 in combination with the alternate embodiment of Figure 6.

See also claim 5.

F) Claim 1 is best understood to be directed toward the embodiment of Figures 1-4, since claim 1 recites structure corresponding to reference numbers 7' and 7". Claim 6 recites structure "...parallel flanges (82, 83)...web (81)...". This feature is only found in Figure 6. Therefore, Applicant would appear to be claiming a "non-disclosed" combination of the embodiment of Figures 1-4 in combination with the alternate embodiment of Figure 6.

See also claim 7.

G) Claim 1 is best understood to be directed toward the embodiment of Figures 1-4, since claim 1 recites structure corresponding to reference numbers 7' and 7". Claim 8 recites structure "...flange (83) into recess (90' 90")...". This feature is only found in Figures 5-8. Therefore, Applicant would appear to be claiming a "non-

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disclosed" combination of the embodiment of Figures 1-4 in combination with the alternate embodiment of Figures 5-8.

H) Claim 10 recites "...the covering layer (4) is concave in the area of the top surface of the ski".

This recited phrase is objected to, as the covering layer is only concave in the "vicinity" of reinforcing profile 8", as shown in Figure 2. Figure 1 shows the top surface 5 and the covering layer 4 to be "parallel".

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claim 1 recites "said ski being resistant to wear and mechanical damage resulting from coming into contact with ski edges of another ski".

There is considered to be inadequate written description for the above recitation due to the following:

A) Support for the above recitation is best understood to be found in paragraph 0014, which recites "...at least one reinforcing profile is provided, which

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extends in the longitudinal direction of the ski along the top edge...and is resistant against wear and mechanical damage resulting from coming into contact with the ski edges of another ski. By this, the outward surface of each reinforcing profile, which may be available in the form of an ordinary ski edge...".

B) From the above, as best understood, the reinforcing profile, defined by the specification as reference numbers 8' and 8" would prevent damage to the ski.

C) However, Figure 1 shows the reinforcing profile, under the top edge 7' and 7". From this, is not clear how reference numbers 7' and 7" would avoid damage. Note that the material of reference numbers 7' and 7" does not appear to have been disclosed.

D) In contrast, Figure 4 shows the reinforcing profile to be the "top surface" of the ski, apparently without reference number 7' and 7" overhead. From this, it is best understood that another ski "crossing over" would directly contact the reinforcing profile. Applicant has not disclosed the material of the reinforcing profile that would be of such strength and hardness that the reinforcing profile would escape damage.

Note also that the above recitation from paragraph 0014 states that the reinforcing profile may be in the form of an ordinary ski edge. From this, it is understood that the reinforcing profile is merely an ordinary top ski edge. Note that this is inconsistent with the teachings of paragraph 0006 which recites "top edges of the metallic layer are relatively resistant against wear and mechanical damage, except against damage caused by contact with a ski edge of another ski". From this, it would

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appear that a top edge of a ski is unsuitable as a reinforcing layer, which is contrary to paragraph to the teachings of paragraph 0014.

Additionally, since the reinforcing layer 8" in Figure 4 appears to be below reference numbers 4 and/or 5, it is unclear how a lower ski edge from another ski "crossing-over" onto the top of the ski of Figure 4 would not damage reference numbers 4 and 5 of Figure 4.

Note also that Figure 5 appears to show the reinforcing profile at the top of the ski, without top edges 7' and 7" above the reinforcing profiles 8' and 8".

Note also that most of dependant claims 2-10 are drawn toward the "alternate embodiment" of Figures 5-8 and the dependant claims all depend from claim 1, which is drawn toward the "main embodiment" of Figures 1-4 due to the recitation of "top edges (7', 7")" in claim 1 and which structure is not present in Figures 5-8.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicants regard as their invention.

Note: The claims are considered to be replete with unclear matter. Therefore, a comprehensive listing of all unclear matter cannot be guaranteed. Applicant is advised to review all claims for unclear matter.

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A) Claim 1 recites the limitation "in the area of exposure to wearing or mechanical damages". There is insufficient antecedent basis for this limitation in the claim.

B) Claim 1 recites the limitation "...the side surfaces...". There is insufficient antecedent basis for this limitation in the claim.

C) Claim 1 recites the limitation "...the forward portion...the rearward portion...". There is insufficient antecedent basis for this limitation in the claim.

D) Claim 1 recites the limitation "...the tip...the ski binding area...". There is insufficient antecedent basis for this limitation in the claim.

E) Claim 1 recites "in the area of each corresponding top edge (7', 7''), or at least in its adjacency...".

The meaning of this phrase is considered unclear.

Note also that this phrase lacks proper antecedent basis.

F) Claim 4 recites "in form of an ordinary ski edge". The meaning of this recited phrase is considered unclear. Note also that to improve wording, that the word "the" should appear before the word "form" in the above recited phrase.

See also claim 5.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

14. Claim 1, as best understood, is rejected under 35 U.S.C. 102(b) as being anticipated by Pilpel, et al, US Patent 4,498,686.

Pilpel teaches a ski comprising:

a sliding layer (12) and longitudinal ski edges (21) on the ski's bottom surface, while above the sliding layer (12) there is a core (25), and above the core (25) there is a covering layer (11) extending over the top surface (15) and over side surfaces (14) of the ski, such that top edges (16) are located between the top surface (5) and side surfaces (12, 13), characterized in that at least in an area of exposure to wearing or

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mechanical damages on the covering layer (11) of the ski and the top edges (16), at least on a forward portion between a tip and a ski binding area (Figure 1), as well as on a rearward portion, below the covering layer (11) in the area of each corresponding top edge (16), at least one reinforcing profile (18) extending in the longitudinal direction of the ski along at least a portion of the top edge (16), said ski being resistant to wear and mechanical damage resulting from coming into contact with ski edges of another ski (see comments below).

Regarding the claim 1 limitation "said ski being resistant to wear and mechanical damage resulting from coming into contact with ski edges of another ski", it is noted this limitation is functional language. The functional recitation of intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the function or intended use, then it meets the claim. *In re Casey*, 370 F.2d 576, 152 USPQ 235, 238 (CCPA 1967). It is the Examiner's position that the prior art is capable of performing the recited functions.

Once this prima facie case has been established, the burden shifts to the applicant to show that the prior art structure does not possess the functionally defined limitations of his claimed apparatus. *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

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Conclusion

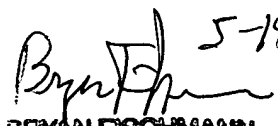
15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schultes, Volkl, Lacroix, Hirnbock, et al, Meatto, Fischer, Scherubl, Legrand, et al, Hayashi, JP 64-34387, DE 3913969, EP 0419779, WO 91/12860 and FR 2696354 – teach ski construction

16. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (571) 272-6694. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis, can be reached on (571) 272-6914. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 5-18-5
BRYAN FISCHMANN
PRIMARY EXAMINER